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REMARKS

Reconsideration of the above identified application is respectfully requested.

On 05/03/2006, the undersigned attorney conducted a phone interview with examiner Watkins to briefly discuss the latest rejections of record over the newly uncovered and cited reference Haggerty.

Various claims and the features thereof were discussed, along with the different interpretations thereof over the applied reference Haggerty. However, no agreement was reached.

Applicant traverses the objection to claims 10, 12, and 25, and for the reasons presented below rewriting thereof is not warranted.

Applicant traverses the omnibus rejection of claims 1-4, 7-9, 11, and 21-24 under Section 102(b) over Haggerty.

Applicant again notes the substantial breadth of interpretation of Applicant's claims being proffered by the examiner during this latest rejection over the disparate reference Haggerty. This broad interpretation will correspondingly enlarge claim scope in later infringement analysis of the file wrapper. However, the examiner has yet again failed to afford due weight to specific features and cooperation of features which distinguish over the applied art.

Fundamental to the examiner's rejection is the admitted failure by the examiner to afford any weight to the "stationery" sheets expressly recited in the claims.

Firstly, MPEP 2111.01 requires the examiner to afford plain meaning to plain English words, like "stationery," not "stationary." And, the Random House dictionary defines "stationery" as writing paper or writing materials like paper, etc.

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Clearly, Haggerty expressly discloses a seal for an oil tank, which seal is made from reinforced rubber or certain plastic materials, col. 1, ll. 1-39.

The examiner's mere contention that that seal is "capable of being used as stationary [sic]" is mere argument, without any evidentiary or legal support, and is against the weight of evidence.

The examiner has failed to show how one skilled in the art of stationery products, or oil seals for that matter, would have understood that the rubber seal of Haggerty is capable of being used as stationery.

Could that rubber seal being placed in a printer and written upon? Of course not, and the examiner has not shown otherwise.

Notwithstanding the examiner's contention, Applicant's specification at paras. 1-10, not simply "003," introduces the quite ubiquitous and notoriously well known stationery products in the typical form of ordinary paper, not rubber, configured for being written upon, such as when passed through a printer.

Is the rubber seal of Haggerty capable of being written on in a printer? Of course, one could write on the rubber seal; but, that alone is not evidence that the seal is a stationery product. Such an argument by the examiner, merely broadens the scope of the claims, which nevertheless have fundamental differences over the rubber seal of Haggerty.

As previously argued, Applicant's claims recite diecuts, more terms of art, and the examiner has not shown that the various slits and holes in Haggerty correspond with stationery diecuts.

Claim 1 additionally recites that the slit diecuts repeat in the stack, yet the slits 7+ and 13+ clearly do not repeat in the stack of four discs 1-4, since discs 3,4 are intentionally different than discs 1,2 (note the missing

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holes 5,6 in discs 3,4).

Claim 2 recites identical configurations for the stack of sheets, yet discs 3,4 are intentionally different than discs 1,2 in Haggerty.

Claim 3 recites the loose stack, and different offsets from the perimeter, which lacks any counterpart in Haggerty.

The examiner merely opines that "the stack of gasket sheets is loose and is only temporarily held by bolts" in Haggerty, but this is clear error.

The bolting in Haggerty must necessarily be permanent, or the seal would be ineffective.

And, the examiner has overlooked the fact that all the slits 7+,13+,15+ in Haggerty appear to have the identical same spacing from the round perimeter of the discs 1-4. Whatever interpretation being proffered by the examiner, this feature must necessarily be applied in the same manner between claim 3 and the reference, and it is quite clear that the slits in Haggerty do not have correspondingly different offsets from the perimeter of the discs.

Claim 7 recites patterns of multiple diecuts offset from each other between the sheets.

The examiner admits in para. 4 that both the slits and holes/apertures in Haggerty are considered "diecuts," and the holes 5,6 and apertures 18 of Haggerty are clearly not offset from each other; but, to the contrary, are intentionally aligned with each other.

Claim 8 recites laterally offset diecut patterns. Neither the apertures 5,6 nor holes 18 in Haggerty are offset at all, let alone laterally.

Claim 9 recites the arcuate diecut and straight diecut which further distinguish over the examiner's rejection of claim 7, since the apertures 5,6 and holes 18 being applied by the examiner are aligned between sheets, and have no offset whatsoever.

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Claim 11 recites the laterally offset diecut patterns from sheet to sheet. Clearly, the apertures 5,6 and holes 18 in Haggerty are not offset at all.

Independent claim 21 recites sheets with identical configurations and diecuts in the stack except for offset which the examiner has overlooked in his comments.

The four discs 1-4 shown in Haggerty include discs 1,2 which are intentionally different than discs 3,4; which do not have identical configurations, and disc 3 is even thicker than the others which is further evidence that it is not identical in configuration.

Furthermore, the discs 1,2 include the center apertures 5,6, which are intentionally not found in discs 3,4, which is more evidence that the discs 1-4 are not identical in configuration. And, the slits 7+ are expressly shorter than the slits 13+,14+, and this provides more evidence that the discs are not identical in configuration.

Claim 22 recites identical patterns of multiple diecuts.

The examiner has admitted to using the slits, apertures, and holes of Haggerty as "diecuts," and clearly the patterns thereof are quite different between discs 1,2 and discs 3,4 in the stack thereof.

Claim 23 recites the different offset of the patterns from the perimeter. However, the hole patterns (18) in the four discs 1-4 in Haggerty clearly must have identical offset from the perimeter in order to align the holes for the bolts, and even this is recognized by the examiner.

Claim 24 recites the practically imperceptible different offset, which according to paras. 25 & 47 is due to the very small 6 mm exemplary spacing.

The examiner has overlooked this claim in his remarks.

Haggerty clearly illustrates 15 degrees of rotational offset among the slits, and the examiner has failed to show how that huge amount is "practically imperceptible" when it

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is quite evident.

The examiner is duty bound to afford some interpretation and plain meaning to claim 24, but clearly has not.

Accordingly, withdrawal of the rejection of claims 1-4, 7-9, 11, and 21-24 under Section 102(b) over Haggerty is warranted and is requested.

Applicant traverses the rejection of claims 5, 6, 20, and 24 under Section 103(a) over Haggerty.

Firstly, the examiner has clearly uncovered the Haggerty reference using the powerful computer searching capability of the PTO, without regard to the search classifications, and analogous art.

The scope of the prior art may be determined from applying *In re Wood and Eversole*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA, 1979):

The determination that a reference is from a nonanalogous art is therefore twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

The field of endeavor in Haggerty is expressly stated by Haggerty as seals for storage tanks, whereas the field of endeavor for Applicant's claims is stationery products, which are quite clearly not the same.

The problem in Haggerty is sealing of gases in a petroleum storage tank, which has no relevance to the interlocking problem when stationery sheets are fed in a printer.

It is also noted, that the examiner is on record for having entered a restriction requirement based on different inventions being in different search classes, and the examiner has failed to show how the search class for Haggerty is within the relevant search class that the examiner himself

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has relied on for the restriction requirement.

For these exemplary reasons, the Haggerty reference is not available for use by the examiner under Section 103.

The fundamental differences of Applicant's claims over Haggerty have been presented above, and the examiner has not established any evidence to contend that the disparate structures in Haggerty are in any way relevant to Applicant's claims.

Claim 5 expressly recites the offset diecuts in conjunction with aligned diecuts in successive sheets for the considerable benefits presented in the specification, which lacks any relevant teaching in Haggerty.

The examiner simply opines that the various features of claims 5, 6, 20, and 24 are mere "variation[s] in the arrangement of slits ... as required by Haggerty is observed." This contention lacks logic, and merit, and lacks any evidence in Haggerty, and is against the very teachings thereof.

At col. 3, ll. 5+, Haggerty expressly teaches that "all the slits are offset with respect to each other, there being a 15° angular shift of each slit when preceding from adjoining discs." Of course, this arrangement is taught by Haggerty as being necessary to effect the improved seal from the stacked discs.

The examiner, therefore, has no evidence in Haggerty to support the mere fabrication that alternate slits in Haggerty could or would have been aligned. What then does the "slits being offset as required by Haggerty is observed" mean when stated by the examiner?

This unintelligible contention of the examiner merely further obfuscates the office action, and provides further evidence of the examiner's failure to afford any weight, let alone due weight to the various features of the various claims.

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Claim 6 recites that the different offsets repeat in successive sheets, yet again overlooked by the examiner, and clearly not supported by Haggerty which expressly teaches that the slits are 15° apart from disc to disc, and it would therefore be against the very teachings of Haggerty to align or repeat them for any reason.

Independent claim 20 recites repeating diecuts, differently offset from the perimeters of the loose sheets, and aligned in successive sheets.

The examiner merely opines that this "variation ... is ... within the ordinary skill ... as required by Haggerty is observed." However, the examiner is clearly wrong, and has provided no evidence in support thereof.

The various slits, apertures, and holes in the four discs 1-4 of Haggerty clearly have identical offsets from the perimeters of those four discs so that they can be properly aligned to be intentionally clamped together by the bolts.

No loose, no different perimeter offset; and clearly no alignment of the slits in the successive sheet. Note again, that Haggerty expressly teaches the 15° angular shift from disc to disc for the intended sealing function, and aligning those slits would clearly eviscerate the sealing effectiveness thereof, notwithstanding the examiner's mere allegation of ordinary skill, lacking in the express teachings of Haggerty, itself.

Claim 24 was first rejected under Section 102, and is now additionally rejected under Section 103, yet the examiner has failed to meet the stringent requirements of MPEP 706.02(j) and ch. 2100 for legal motivation lacking in the Haggerty reference.

Claim 24 recites practically imperceptible, and quite clearly, the 15° shift in Haggerty is well perceived, and the examiner has not shown otherwise.

The examiner has overlooked the whole analysis of each

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claim and the reference Haggerty itself.

Applicant's product is a stack of stationery sheets specifically configured for use in a printer, and that stack should appear identical to its intended user. The problem in the identical sheets is the interlocking of the diecuts which would be identically aligned, but for the invention which offsets them.

There is nothing imperceptible in the discs 1-4 of Haggerty, and indeed, the large angular shift of 15° is fundamental in achieving the improved seal from the stack thereof.

Assuming arguendo that the angular shift were practically imperceptible in Haggerty, one could then use the small 6 mm spacing from Applicant's specification as an example to shift the outer ends of the various slits.

Would not then those radiating slits be visually aligned with each other? And, would not then the sealing effectiveness thereof be essentially destroyed? The examiner has overlooked this in the rush to reject.

The examiner applies Applicant's claims in the generality and breadth common in USPTO examination practice, and applies the various references equally loosely in the broad interpretation thereof.

But, the MPEP and case law therein require otherwise. They require stringent analysis, based on identified evidence, and with legal motivation, which is not met by the examiner's hindsight fabrication of rejections based on the mere "ordinary skill" when the very reference Haggerty being applied by Haggerty is against that very "ordinary skill" that the examiner attempts to apply, without regard to its very express teachings.

Accordingly, withdrawal of the rejection of claims 5, 6, 20, and 24 under Section 103(a) over Haggerty is warranted and is requested.

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It is quite clear that the USPTO, under the ardent representation of the examiner, continues to present remarkably broad interpretations of claims, features therein, and the various references being applied.

Where then are the metes and bounds of the present claims to be made?

During the phone interviews with the examiner, the examiner has consistently maintained remarkably broad interpretations of the claims and references; and the fundamental differences in interpretations of the claims and references is well apparent.

However, it is quite certain that Applicant's invention as disclosed in the specification and illustrated in the figures is quite, quite different than any of the references applied in the past, as well as the present Haggerty reference.

Note, in particular, that the discs 1-4 in Haggerty include both the slits shifted from each other, and the center apertures 5,6 and outer bolt holes 18 which are necessarily aligned with each other. The examiner considers both the slits and apertures/holes of Haggerty as "diecuts," yet has failed to afford due weight to the fundamentally different configurations.

In Applicant's stack of stationary sheets, the main object is to have them appear identical to the intended user, with identical configurations, but without the undesirable interlocking problem.

So, by preferentially offsetting the diecuts in adjoining sheets, the successive sheets may remain identical in all manner, with the intervening sheets being slightly different to avoid interlocking of the diecuts.

These features are presented in significant detail in the specification, both for the form of the stacked sheets, as well as in the novel method of making thereof.

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Accordingly, in an attempt to terminate sooner rather than later, the prosecution of the present application, now having three office actions on the merits, in addition to the restriction requirement and the withdrawn notice of allowance, Applicant is yet again offering additional amendments to the independent claims consistent with the latest discussion thereof during the phone interview.

Figures 2 & 3 clearly illustrate the two forms of the sheets 10a,b arranged in a stack of 2,000 or 2,500 sheets.

The first sheets 10a are identical to each other in the entire stack.

The second sheets 10b are identical to each other in the entire stack.

The first and second sheets 10a,b are also identical to each other, except for the offset patterns of diecuts 16a,b,c; which patterns themselves are identical to each other as well.

In the exemplary embodiment, the two patterns are offset differently from the perimeter of the sheets 10a,b by the corresponding offsets A,B.

These features are well disclosed in the specification, and paras. 32 & 33 are representative of these important features.

Accordingly, independent claims 1, 20, and 21 are being amended in related manners to further emphasize the alternating repetition of the diecuts in the manner of the stacked 10a,10b,10a,10b etc series, which is well distinguishable over the references of record, including Haggerty.

In claim 1, the slit diecuts are both offset among the sheets, and repeat identically in alignment in alternating sheets throughout the stack.

In claim 20, the repeating diecuts have different perimeter offsets in the adjoining sheets, and repeat

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identically in alignment in the next successive sheets throughout the stack. In this way, the sheets alternate in identical configurations and diecuts, but with the adjoining sheets having offset diecuts.

And, in claim 21, the first and second sheets 10a,b adjoin each other and alternate in the entire stack, with the first sheets 10a being identical, the second sheets 10b being identical, and the diecuts therein being offset from each other. In this way, the alternate sheets 10a,b are identical in configuration and alignment of their diecuts, while the adjoining sheets have offset diecuts.

As indicated above, Haggerty necessarily discloses two fundamental features: (1) that the bolt holes 18 (diecuts according to the examiner) are necessarily aligned in the entire stack of four discs 1-4; and the various slits 7+, 13+, 15+ are shifted 15° from each other, and are therefore not aligned. And, the center apertures 5,6 are aligned in discs 1,2, but discs 3,4 do not have any such center apertures.

Accordingly, in the entire stack of four discs 1-4 in Haggerty there are no corresponding discs which are identical as they alternate, and in which diecuts are found that are both offset in adjoining discs and aligned in alternate discs.

Independent claims 1, 20, and 21 as now amended therefore further emphasize the repeating, but offset nature of the diecut configurations of the stacked stationery sheets which solves the interlocking problem.

There is no counterpart of structure and teaching in Haggerty; and to the contrary, Haggerty expressly teaches angularly shifted slits cooperating with aligned apertures and bolt holes because the intended use of those discs is for a seal, whereas the intended use of Applicant's stack of sheets is for a stationery product in a printer.

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A Section 102 analysis may be blind to the whole analysis and the intended use, but a Section 103 cannot be.

A Section 102 analysis is technical, and the claims as further amended are clearly not anticipated by the disparate combination of Haggerty.

And, the Section 103 analysis mandates a review of the whole, and requires due weight to express claim language, and the problem being solved, and the intended use in which that problem is solved.

The multi-disc seal of Haggerty is clearly nonanalogous art, and only emphasizes the remarkably broad interpretation of Applicant's claims being afforded by the PTO.

Those claims now further distinguish over Haggerty in fundamental structure, for which the examiner must afford due weight since the examiner fails to afford due weight to the stationery, diecut, repeating, and offset features of the claims in the combinations recited.

In view of the amendments to the three independent claims, the various dependent claims are yet further distinguishable over the Haggerty reference for the reasons presented above, and are additionally distinguishable over this reference in view of the new combination thereof with the additional features now found in the independent claims.

In accordance with the duty imposed by 37 CFR 1.104 and MPEP sections 707, 707.05, 707.07, and 707.07(g), the examiner will no doubt reconsider all the art of record to ensure full compliance with the required thoroughness of examination; it being noted that the examiner has now updated his search effort.

In re Portola Packaging, Inc., 42 USPQ2d 1295 (Fed. Cir. 1997) emphasizes the importance of complying with this duty to ensure that all references of record have been fully considered by the examiner in the various combinations thereof. And, the Board of Appeals has further elaborated on

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the importance of this examiner duty in Ex parte Schriker, 56 USPQ2d 1723 (B.P.A.I. 2000).

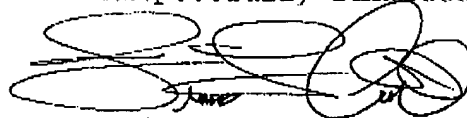
In view of the above remarks, allowance of claims 1-12 and 20-25, over the art of record is warranted and is requested.

And, withdrawal of the restriction requirement is further warranted and requested; and method claims 13-19 should now be rejoined, and the prior art search again updated specifically therefor, along with due examination of these method claims as well. See MPEP 821.04.

Those method claims 13-19 are well distinguishable over the Haggerty, which clearly provides no teaching of any related method of making the individual rubber discs 1-4 thereof.

Allowance of method claims 13-19 is also warranted and is requested.

Respectfully submitted,



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